

**Office Action Summary**

Application No.

09/864,038

Applicant(s)

ZEE, CHRISTOPHER

Examiner

Kuen S Lu

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,2,9-13,19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/22/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

U.S. DEPARTMENT OF COMMERCE

PATENT AND TRADEMARK OFFICE

EXAMINER'S CASE ACTION WORKSHEET

Application No.  
09/864,038



Legal Instrument Examiner

CHECK TYPE OF ACTION

DATE OF COUNT

<input type="checkbox"/> Non-Final Rejection	<input type="checkbox"/> Restriction/Election Only	<input checked="" type="checkbox"/> Final Rejection
<input type="checkbox"/> Ex Parte Quayle	<input type="checkbox"/> Allowance	<input type="checkbox"/> Advisory Action
<input type="checkbox"/> Examiner's Answer	<input type="checkbox"/> Reply Brief Noted	<input type="checkbox"/> Non-Entry of Reply Brief
<input type="checkbox"/> Defective Notice of Appeal	<input type="checkbox"/> Interference Disposal SPE _____ (Approval for Disposal)	<input type="checkbox"/> Suspension (Examiner-Initiated) SPE _____ (initial)
<input type="checkbox"/> Defective Appeal Brief	<input type="checkbox"/> SIR Disposal (use only after FAOM)	<input type="checkbox"/> Supplemental Examiner's Amendment
<input type="checkbox"/> Miscellaneous Office Letter (With Shortened Statutory Period Set)	<input type="checkbox"/> Notice of Non-Responsive Amendment (With One Month Time Period set)	<input type="checkbox"/> Miscellaneous Office Letter (No Response Period Set)
<input type="checkbox"/> Abandonment after BPAI Decision	<input type="checkbox"/> Supplemental Action (excluding Examiner's Answer)	<input type="checkbox"/> Response to Rule 312 Amendment
<input type="checkbox"/> Letter Restarting Period for Response (e.g., Missing References)	<input type="checkbox"/> Interview Summary	<input type="checkbox"/> Authorization to Change Previous Office Action SPE: _____ (Initial)
<input type="checkbox"/> Abandonment	<input type="checkbox"/> Express Abandonment Date: _____	<input type="checkbox"/> Other Specify: _____

Examiner's Name: Kuen S Lu

AU: 2177

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. For compact prosecution, Examiner assumes "such as" corresponds to "at least one of".
2. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases "deemed worth" and "being worthy" render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. For compact prosecution, Examiner assumes "deemed worth" and "being worthy" are meant to include all archived IPs.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 2, 10-13 and 19-24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Watanabe et al. (U.S. Patent 6,157,947, hereafter "Watanabe") and further in view of Kimata (U.S. Pub. 2001/0034617 A1).

As per Claim 3, Watanabe teaches "providing an information storage and retrieval archival system containing plural archived intellectual property (IP)" at Fig. 15 and col. 15, lines 24-39 by teaching an IP distribution system for storage and catalog of IPs.

Watanabe does not teach user fee or endowment fund.

However, Kimata teaches "enabling a user fee based access to the archived" medical information "in the information storage and retrieval system by users through an electronic communications network" at Figure 9 and Page 13, [0176] by charging a user with fees for registration of individual treatment information and for that use of the networked system.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Kimata's teaching with Watanabe's by establishing the user fee system in the IP storage and retrieval archival system because by doing so the users could share the cost for maintaining the IP database and guaranteeing its continual growth for more users to share.

Kimata further teaches "funding an endowment trust from archival fees, said endowment trust being separately managed to provide enduring funding for the maintenance and operation of the storage and retrieval archival system to assure continued availability of the archived" medical data "regardless of access thereto" at Page 13, [0176] by corresponding the relevant registration fee or usage fee with the database management fund for providing the funding for the maintenance and operation

of the database where the management of the fund is managed as taught at Figures 16 and 18 by showing a plurality of cooperating companies for performing a plurality of functions.

As per Claim 2, Watanabe teaches "receiving instructions for the accessing and amendment of the archived IP from the users" at Fig. 26, step 302 for IP registration and step 303 for IP deletion and update; and "saving the received Instructions for accessing and amendment of the archived IP and indexing the saved received instructions to the archived IP and to a set of user defined key words, linkages and attributes of, and related to, the received instructions and the archived IP" at Figures 7B, 8A-8C and col. 6, lines 55-67 by using screen menus for entering, saving and performing instructions for registering, retrieving, updating and deleting IPs where keywords are entered in the specific fields and IP information indexed in the fields.

As per Claim 10, Watanabe teaches "the indexing step comprises assembling information taken from an aspects list of: intellectual property type, country of publication, author name, assignee, revenue sharing ratio, bank account, keywords, abstract, excerpts, ISBN number, ISSN number, publication date, volume number, issue number, page number, file format, file size, language rating, and violence rating" at Figure 7B by registering IP including IP name, Large, medium and small categories, disclosure extent, corresponding technology, etc.

As per Claim 11, Watanabe teaches "access step comprises at least one of the further steps of: reviewing a list of archived IP retrieved, selecting specific intellectual property to access, selecting a level of access, paying an access fee, and receiving

the selected intellectual property” at Figures 8B-8C and col. 6, lines 60-67 by using retrieval and display menus for logging in, retrieving and displaying the retrieved IP information.

As per Claim 12, Watanabe teaches “receiving instructions for access step includes at least one of the further steps of: determining if the user is a member, signing the user as member, accepting agreement, paying membership fee, downloading access software, receiving open credit balance, reviewing fee schedule, selecting level of access, and paying further search and retrieval fees” at Figure 7B and col. 6, lines 55-67 by using login process to use the system which implies selecting the level of access.

As per Claim 13, The method of claim 12 wherein the receiving instructions for access level step includes at least one of the further steps of:  
“determining if the user has been granted permission, by the owner of the archived IP, to access to the selected IP; and verifying the identity of the user using methods such as, user id, password, computer id, CPU id, secondary password, smart, cards, encoded Credit and biometric identification systems” at Figure 7B and col. 6, lines 55-67 by using login process which require the use of user id and password.

As for Claim 19, Watanabe teaches “establishing a Permanent IP Identification Address (PIPA) for identifying the address of the archived IP in a Permanent IP Domain (PIPD)” at Figure 7B and col. 6, lines 55-67 by using the large category as the domain of IP while IP number is the permanent identification address.

As for Claim 20, Watanabe teaches "managing the PIPD by operator-managers" at Fig. 14 and col. 14, lines 50-65 by managing the IPs based on their categories.

Watanabe does not teach "separately managing the endowment trust from the management of the PIPD".

However, Kimata teaches establishing database fund by collecting user registration and use fee.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Kimata's teaching with Watanabe's by establishing fund collecting from IP registration and use and placing its management separately from the management of IP storage and archival, since the management of fund is financial in nature while IP management deals with intellectual property.

As per Claim 21, Kimata further teaches accessing an archival fee associated with archived medical record at Page 13, [0176] by charging user with use fee and charging user and hospital with registration fee when necessary such that the database management fund is possible to reduce the cost of participating hospitals.

As for Claim 22, Kimata further teaches augmenting the database management fund by charging user and hospital with registration fee when necessary such that the cost shouldered by the participating hospitals can be reduced at Page 13, [0176].

As per Claim 23, Kimata teaches pooling database management funds for a plurality of medical records through use, and registration when necessary which can further enhancing the permanence of the fund by including increased liquidity and reduced risk at Page 13, [0176].



As per Claim 24, Watanabe teaches each IP record containing large category as the domain and IP number as the identification at Fig. 7B and col. 7, lines 55-67, "establishing one or more access files separate from the archived" at Fig. 7B and col. 6, lines 55-67 by exporting the registered IP to a local file, and "each access file associated with a user" and "enabling access to an access file by a user wherein each access file comprises the PIPA for the archived IP, an identity of the user, and value-added information by the user" at Figures 6-7B and col. 6, lines 39-49 and 55-59 by registering PIPA (IP number) for the archived IP, username and valued-added information.

As per Claim 25, Watanabe teaches "accessing a users access file by the accessing user" at Fig. 7B and col. 6, lines 55-67 by importing a local file to display the registered IP, "combining the value-added information and the archived IP into a combined product" and "presenting the combined product to the accessing user" at col. 6, lines 39-49 and 55-59 by registering PIPA (IP number) for the archived IP, username and valued-added information and presenting the combined product by the accessing user at Fig. 7B and col. 6, lines 55-67 by displaying the registered IP.

As per Claim 26, Watanabe teaches "accessing a first users first access file by a second user for forming a second access file" at Fig. 7B and col. 6, lines 55-67 by importing a local file created through exporting an archived IP by a first users; "combining value-added information of the first and second access files and the archived IP of the into a combined product; and presenting the combined product to the second accessing user" at Figure 7B by combining the value-added information

through registering IP data, including IP name, Large, medium and small categories, disclosure extent, corresponding technology, etc.

As per Claim 27, Watanabe teaches "opening an access file and obtaining a presentation of the combined product including at least the PIPA for the archived IP and the permanently archived IP associated therewith" " at Fig. 7B, col. 6, lines 55-67 by importing a local file for an archived IP whose value-added information was combined by local file exporting, registration and importing processes.

As per Claim 28, Watanabe teaches "initiating the creation of an access file by a user by the entry of information associated with the archived IP; and once the archived IP is identified, the PIPA for the archived IP, an identity of the user, and value-added information by the user can be added to the access file" at Fig. 7B, col. 6, lines 55-67 by importing a local file of an archived IP, updating the menu with the IP number, username and value-added information, and saving and/or exporting the updated.

As per Claim 29, Watanabe teaches "searching a plurality of access files to ascertain if archived IP is stored for retrieval, and if so opening the access file associated with the archived IP for obtaining a presentation of the combined product including at least the PIPA for the archived IP and the permanently archived IP associated therewith" at Fig. 7B and col. 6, lines 55-67 by importing local file corresponding with the archived IP through local file name.

As per Claim 30, Watanabe teaches storage and archival of IP by registering IP with IP information, including name, username, number, large category, etc.

Watanabe does not specifically teach creating endowment fund as "IP owners only fund an endowment fund for archived IP deemed worthy, and PIPA are established only for archived IP, and thus the information and retrieval system only contains archived IP deemed by IP owners as being worthy".

However, Kimata teaches database fund for the management of medical records registered and used by individuals and hospitals where owner of the records may be the user and cooperating company be the management of the fund at Page 10, [0143].

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Kimata's teaching with Watanabe's by establishing the user fee system in the IP storage and retrieval archival system because by doing so the users could share the cost for maintaining the IP database and guaranteeing its continual growth for more users to share.

As per Claim 31, Watanabe teaches exporting archived into a local file at Fig. 7B and col. 6, lines 55-67.

Watanabe does not teach "step of establishing an index tag for each archived IP and comprising at least a PIPA for the archived IP, the index tags being useful for indexing purposes".

However, Kimata teaches creating home page for medical records at Fig. 16.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Kimata's teaching with Watanabe's by indexing archived IP information into web page such that the IP data could be more

available at the web site which would have enhanced functionality of Watanabe's system.

As per Claim 32, Watanabe teaches "backing up the access file on the storage and retrieval archival system operated in the PIPD" at Fig. 7B and col. 55-67 by exporting the same archived IP to local files placing at different drives or backup media.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (U.S. Patent 6,157,947, hereafter "Watanabe") and in view of Kimata (U.S. Pub. 2001/0034617 A1), as applied to Claims 3 and 2, and further in view of Couchman (Oracle DBA Certification Exam Guide, Oracle Press, 1998) and Baba et al. (U.S. Patent 5,758,057).

As per claim 9, the combined Watanabe-Kimata teaches IP archived and storage system by networking database servers and client systems.

Neither Watanabe nor Kimata teaches system backup, mirroring, disaster recovery or multi-media equipments settings.

However, Baba teaches mirror system configuration at Fig. 1, elements 011a and 100b, col. 8, lines 23-24, and multi-media storage configuration and user connections at Fig. 5, col. 9, lines 21-25.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Kimata and Baba's references into Watanabe's system by specifically mirroring disk drives so that all archived IPs would have an on-line and redundant backup to ensure any storage failure could be repaired while the information archiving and retrieving system maintained operational.

The combined Watanabe-Kimata-Baba reference teaches IP storage and archived system equipped with mirror disk drives.

Neither Watanabe, Kimata nor Baba teaches disaster recovery for the IP archiving and retrieving system.

However, Couchman teaches physical disaster recovery system at Chapters 13-15.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Couchman, Kimata and Baba's references with Watanabe's by implementing a disaster recovery system which must be remotely located such that the Watanabe's IP archiving and retrieving system would be fully reliable during the events of system fault or natural disaster because of redundant copies, different principles of practice and remotely storage of backups.

### ***Conclusions***

5.

The prior art made of record

A. ~~U.S. Patent~~ 6,157,940

*W. Lee 3/12/04*

B. U.S. Publication 2001/0034617 A1

C. U.S. Patent 5,758,057

U. Oracle DBA Certification Exam Guide, J. Couchman  
Oracle Press, 1998

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

D. U.S. Patent 6,157,947

6. **THIS ACTION IS MADE FINAL.**

The Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 703-305-4894. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number: 09/864,038  
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Page 13

KL

Patent Examiner

February 11, 2004

*John E. Breene*  
JOHN BREENE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100